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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,775	06/29/2001	Will H. Gardenswartz	209745US25XCONT	5962
22850	7590	08/18/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				CHAMPAGNE, DONALD
ART UNIT		PAPER NUMBER		
3622				

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/893,775	GARDENSWARTZ ET AL.
	Examiner	Art Unit
	Donald L. Champagne	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 18 May 2004.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-9, 15-23, 29-37 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9, 15-23, 29-37 and 44-53 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 May 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed with an amendment on 18 May 2004 have been fully considered but they are not persuasive. The arguments are addressed by rewriting the last Office action at para. 7-8 below and explicitly at para. 9-10 and 17 below.

### ***Failure to Comply with 37 CFR 1.121(c)***

2. The amendment to the claims does not comply with the requirements of 37 CFR 1.121(c) because changes are not marked for the two "currently amended" claims 15 and 31. See the **bold** highlight of the following copy of 37 CFR 1.121(c)(2):

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

**No immediate action is required by applicant.** The examiner was able to determine how the two claims were changed. However, applicant is cautioned that future deviations from the requirements of 37 CFR 1.121(c) will result in a requirement to bring the amendment into compliance.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9, 15-23, 29-37 and 43 are rejected under 35 USC 103(a) as obvious over Biorge et al. in view of Stein et al. (US pat. 5,459,306) and Herz et al.
5. Biorge et al. teaches (independent claims 1, 15 and 29) a method, a computer readable medium containing a computer program for executing the method, and a system for delivering *incentive credits*, which reads on targeted advertising, comprising: receiving from a first computer (*the portable device*) a first identifier (*encrypted signals*) identifying the first computer, and

associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/ targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.

6. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer. A “purchase” is an exchange for money or its equivalent (Merriam-Webster’s Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase.
7. Biorge et al. does not teach that that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (*user code*, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer. Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al.
8. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.
9. Applicant argues (p. 14) that Herz et al. teaches means by which the consumer identity is released with their consent. That is true but irrelevant. The consumer can do anything they want with their own private information. Herz et al. is relevant because it teaches that at least some consumers want data related to their purchase history (*purchasing patterns* at line 38 and *purchasing behavior* at line 41) to be kept confidential. That would make it obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.

10. Applicant also argues (p. 13, second para. from the end) that Stein et al. does share the purchase history data of the consumer with the *host system 13* that determines the targeted advertising. The reference does teach that the purchase history data of the consumer is stored in (shared with) the *host system 13* (col. 4 lines 14-19). But the reference does not teach that the *host system 13* "determines" anything. Indeed, there is no such limitation in the claim, so it appears that applicant is implying that "determining" the ad has something to do with providing to an advertiser said purchase history. The reference does teach (col. 5 lines 6-9) that said *host system 13* *informs* the *POS computer 11* of promotions (ads), which can be interpreted as sending ads to the *POS computer 11*. Applicant may interpret this as "determining" the ads, but it still has nothing to do with providing to an advertiser said purchase history.
11. Biorge et al. also teaches (independent claims 3, 17 and 31, and dependent claims 2, 4, 16, 18, 30 and 32) *generating* the first identifier (*encrypted signals*, col. 10 lines 22-26), where *encrypted signals* reads on a cookie.
12. Biorge et al. does not teach (claim 43) delivering the targeted ad over the Internet. However, the reference does teach a communications network (col. 9 line 16) necessary to complete electronic delivery of the targeted advertisement/*incentive credits* to the consumer at the first computer. Because the Internet is efficient, economical and readily available for data transfers of this kind, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use the Internet as the communications network.
13. Biorge et al teaches (claims 5, 19 and 33) receiving a second identifier (*user code*, col. 5 lines 5-10) corresponding to the consumer from the first computer. Biorge et al. also teaches that the consumer carries the first computer (*the portable device*) and enters the user code therein to validate the user (col. 5 lines 3-8), which reads on associating the first identifier with the consumer by linking the first identifier to the second identifier.
14. Biorge et al does not teach sending the first identifier to the first computer. However, since Biorge et al. teaches the method claimed, under the principles of inherency (MPEP § 2112.02) the invention is considered to be anticipated in this regard by Biorge et al. As evidence tending to show inherency, it is noted that the first identifier must be placed within the first computer, even at the time of its manufacture, and that reads on sending the identifier to the computer.

15. Biorge et al also teaches (claims 6, 20 and 34) classifying the consumer by purchase behavior/history and selecting the credit/ targeted advertising based thereon (col. 5 lines 23-27). Biorge et al also teaches (claims 7, 21 and 35) that the targeted advertisement is a credit, which is an inherent incentive to change or continue an established purchase behavior.
16. Biorge et al. does not teach (claims 8, 22 and 36) that the behavioral pattern also includes purchasing the product (see para. 12 below) within a time period. Official notice of this common knowledge or well known in the art statement was taken in the last Office action (Paper No. 10, mailed 14 July 2003). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)
17. Applicant traverses (p. 14-15) the taking of official notice in para 16 above. As noted in the last sentence of that para., the permissible time for traversing is past.
18. Biorge et al. teaches (claims 9, 23 and 37) presenting an award to the consumer in a retail store if the consumer complies with the behavioral pattern (col. 5 lines 32-33), where the behavioral pattern is defined by an amount of at least one specified product (col. 5 lines 57-59).
19. Claim 44 is rejected under 35 USC 103(a) as obvious over Stewart in view of Stein et al. (US pat. 5,459,306) and Herz et al.
20. Stewart teaches a method for delivering a targeted advertisement (title), comprising: receiving from a first computer (the *PDA*, col. 1 line 23) a first identifier (*identification code*, col. 4 lines 1-7) identifying the first computer, and associated with an observed offline purchase history of a consumer (col. 6 lines 60-67), including purchase information collected when the purchase transpired, and electronically delivering the targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 8 lines 51-52). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.
21. Stewart does not teach that said purchase was offline and not transacted with the first computer. The reference teaches a host of suppliers and services (col. 6 lines 49-53), at least some of which are seldom, if ever, purchased on-line (e.g. taxi services). Hence, it

would have been obvious to one of ordinary skill in the art, at the time of the invention, to purchase at least some of these services off-line (e.g. taxi services) because these services are seldom available as required on-line. Since the purchase was not online, it could not have been transacted with the PDA first computer.

22. Stewart does not teach that that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (user code, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer. Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Stewart
23. Stewart does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.
24. Stewart does not explicitly teach displaying the targeted ad on the first computer. However, this is obvious because the first computer is a PDA on which the vast bulk of received information is displayed.
25. Claims 45-53 are rejected under 35 USC 103(a) as obvious over Biorge et al. in view of Stein et al. (US pat. 5,459,306) and Herz et al. and further in view of Merriman et al. (US005948061A).
26. Neither Biorge et al., Stein et al. nor Herz et al. teach a cookie and a cookie number in the first computer, and association of the cookie number with a consumer identification. Merriman et al. teaches (col. 5 lines 19-20) a cookie on the first computer containing the user's ID number, which reads on a cookie and a cookie number in the first computer, and association of the cookie number with a consumer identification. Because cookies are well-known and efficient means for storing and transferring a user ID, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Merriman et al. to those of Biorge et al., Stein et al. and Herz et al.

***Conclusion***

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
30. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
31. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues,

or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

32. Applicant may have after final arguments considered and amendments entered by filing an RCE.

33. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

14 August 2004

A handwritten signature in black ink, appearing to read "Donald L. Champagne", is written over a diagonal line. The signature is fluid and cursive, with a large, stylized 'D' at the beginning.